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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,232	07/02/2001	Uday W. Joshi	F-281	1871
919	7590	09/08/2005	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			NGUYEN, CUONG H	
		ART UNIT		PAPER NUMBER
		3661		
DATE MAILED: 09/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/898,232	JOSHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	CUONG H. NGUYEN	3661	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 21 March 2005.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-7,9,18 and 19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7,9,18 and 19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | Paper No(s)/Mail Date _____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This Office Action is the answer to the Response to Restriction paper received on 3/21/2005. The arguments are persuasive; therefore, claims 1-7, 9, and 18-19 are examined below

### **Drawings**

2. The drawings (received on 7/02/2001) are acceptable for examining purposes.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. §103(a), which forms the basis for all obviousness rejections set forth in this Office Action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

3. **Claims 1-2, 5, 9 and 18-19 are rejected under 35 U.S.C. §103(a) are rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. (US Pat. 5,982,994).**

A. Per claims 1-2, and 18-19: Mori et al. suggest a method/system for generating a mailing using Internet, comprising:

- storing at a data center samples in a viewable format viewable for remote (CLIENTS 52) uses (i.e., a HARD DISK 24, see Mori et al., Fig.1, ref 24);
- receiving a request for printing (e.g., an order from CLIENT 52, or a design for a mail piece – see Mori et al., Fig.27, Fig.18, ref. 523' or Fig.25, ref. 559);
- converting said design to a viewable format (see Mori et al., col. 13 lines 6-12, and col. 21 lines 11-24), said viewable format being viewable from a remote computer (CLIENT 52) via a network (see Mori et al., Figs.1, 11);

- receiving an order for a plurality of pieces of said at least one mail piece from said remote computer via said network see Mori et al., Fig.1, Fig.27, Fig.18, ref. 523', or Fig.25, ref. 559);
- combining said order with another order to produce a single print run, then printing each sample (a first mail piece and a second mail piece) on a paper (see Mori et al., col. 18 lines 54-55 wherein Mori et al. suggest that 2 different samples/inputs can be printed upon selecting a "both-side printing" button);
- Mori et al. obviously suggest about arranging those single print runs in a presort sequence – Mori et al. teach in the abstract that printing jobs can be sorted out into the order of clients (e.g., using address/location as a base-line for sorting).

Mori et al. do not disclose about physically mailing finished mail pieces.

However, it would have been obvious with one of ordinary skill in the art at the time of invention to recognize that Mori et al. distribute/sending printed jobs after finishing – e.g., mailing finished mail pieces (see Mori et al., Fig.44) for the benefit of completing the required mailings because sending finished mail pieces are now more simpler from that presorting sequence step.

B. Per claim 5: Mori et al. suggest about receiving customized info. to print on a sample/mail piece, e.g., a font type (see Mori et al., col. 21 lines 34-52).

C. Per claim 9: Mori et al. suggest about receiving a design from a first business, and receiving another design by a different party (see Mori et al., Fig.1 for a network communication of different CLIENT 52 to a NETWORK PRINTER APPARATUS 20).

4. **Claims 3-4, 6-7, and 9 are rejected under 35 U.S.C. §103(a) are rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. (US Pat. 5,982,994), in view of Fabel (US Pat. 6,209,779).**

A. Per claims 3-4: Mori et al. suggest of receiving contact information (this information may include receiver addresses, see Mori et al., these data are obvious in Fig.27 "INFORMATION NOTICE").

Mori et al. do not expressly disclose that contact information is printed on a sample/a mail piece.

However, Fabel teaches that idea (e.g., including RETURN ADDRESS or ADDRESSEE ADDRESS, receiving respective contact information which is a recipient mailing list including names, wherein each name is printed on a mail piece - see Fabel, Fig.15).

It would have been obvious with one of ordinary skill in the art at the time of invention to combine Mori et al., and Fabel to disclose that contact information is printed on a sample/a mail piece for mailing to an addressee.

B. Per claim 6: Mori et al. do not disclose a printed job on a postcard. However, Fabel teaches about printing on a post card having a first and second side (see Fabel, the abstract).

C. Per claim 7: Mori et al. suggest a step of printing on first side and second side of a sheet (see Mori et al., Fig.27 wherein the selected type of data is "BOTH-SIDE PRINTING").

Mori et al. do not teach that print job is a postcard printing job.

However, Fabel teach that limitation (see Fabel, the abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine both Mori et al., and Fabel for printing on a postcard with 2 sides instead of a plain

sheet because a postcard is made by a thicker sheet of paper. Mori et al.'s printer can be adjusted paper thickness to accept a thicker paper than regular papers for postcards as suggested by Fabel.

***Response***

5. The examiner respectfully submits that the amended claims are unpersuasive; although Mori et al.'s patent is not directed to generating a mailing (REMARKS of 12/06/2004, page 6 of 9, para.3), Mori et al. disclose a system, and a method that are capable of doing what the applicants claim (further after print out a hard copy, one of the purpose of that act is sending/mailing that copy away from sorting out print jobs in specified orders) – please note that Mori et al. suggest of using a system to prepare a hardcopy for a mailing – the ONLY THING in independent claim 1 is Mori et al. do not physically mail those hard-copies away. The claimed subject matters are combining elements, printing on a single print run for each combination, then sorting them before mailing away. Cited prior art disclose those actions; therefore, these steps are not inventive.

On page 6, para. 4 (of the 12/06/2004 REMARKS), the applicants argue "There is no disclosure, teaching or suggestion in Mori et al. of storing a data center a design for each of a plurality of mail pieces as is recited in claim 1", the examiner disagrees (i.e., HARD DISK 24 can do above claimed function, see Mori et al., Fig.1).

***Conclusion***

6. Claims 1-7, 9, and 18-19 are not patentable. The submitted amendment is unpersuasive; accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose tel. number is 571-272-6759. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Serial Number: 09/898,232

Art Unit: 3661

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.



CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3661